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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/733,155
Filing Date: December 11, 2003
Appellant(s): MODHA ET AL.

Alan R. Marshall
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 4, 2008 appealing from the Office action mailed May 28, 2008.

The appeal brief is filed in the new format under the revised BPAI final rule before the effective date of the BPAI final rule. The Office published the BPAI final rule to amend the rules governing practice before the BPAI in *ex parte* patent appeals. *See Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Final Rule, 73 FR 32938 (June 10, 2008), 1332 Off. Gaz. Pat. Office 47 (July 1, 2008).* However, the effective date for the BPAI final rule has been delayed. *See Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Delay of Effective and Applicability Dates, 73 FR 74972 (December 10, 2008).* In the notice published on November 20, 2008, the Office indicated that the Office will not hold an appeal brief as non-compliant solely for following the new format even though it is filed before the effective date. *See Clarification of the Effective Date Provision in the Final Rule for Ex Parte Appeals, 73 FR 70282 (November 20, 2008).* Since the appeal brief is otherwise acceptable, the Office has accepted the appeal brief filed by appellant.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(3) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(4) Claims Appendix

The statement of the status of claims contained in the brief is correct.

(5) Evidence Relied Upon

WO 02/32475	International Publication (TEOH et al)	4-2002
5,284,607	CHEN	2-1994
3,740262	AGOSTINELLI	6-1973
2003/0100694	HOLGUIN	5-2003

(6) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 77-84, 88-91, 94-102, 106-109 and 112-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Publication WO 02/32475 (see page 6, first full paragraph; page 8, last paragraph; and page 2, top) in view of Chen (col. 2, lines 6-7; col. 4, lines 35-44) and Agostinelli (see Example 1).

PCT Publication -475 (hereafter referred to as Teoh et al) discloses the basic claimed method of forming an elastomeric glove including the dipping of a hand-shaped

former into a bath of elastomeric material to form a substrate body, applying a hydrogel coating to the outer surface of the substrate body while the inner surface remains adjacent to the former and applying (see page 8, last paragraph) a silicone surfactant -- ie, lubricant coating—to the hydrogel. See page 6, the first full paragraph for the basic steps. Essentially, Teoh et al fails to teach the exact thickness of the hydrogel coating, that the lubricant coating is a silicone emulsion and that the glove is chlorinated prior to stripping it off the former. The exact thickness of the hydrogel coating is submitted to have been an obvious feature dependent on the ease of donning of the glove, something that would have been readily determined through routine experimentation. Chen discloses applying a silicone emulsion onto underlying elastomeric layers when forming a glove—see col. 2, lines 6-7. It certainly would have been obvious to have employed a silicone emulsion as taught by Chen for the silicone lubricant coating disclosed in Teoh et al dependent on the exact silicone formulation desired. Emulsions are obviously well known and would have been a convenient way to apply the silicone lubricant in a dipping step. Concerning the chlorination, both Teoh et al (see paragraph bridging pages 1 and 2) and Chen (see col. 4, lines 35-44) disclose that such is a well known step to prevent the rubber from sticking together—ie, reduce the tackiness of the glove. Teoh et al teaches that chlorination is known in the prior art but that such is only a partial solution to the problem of tack (see page 2, first full paragraph). Chen discloses chlorination of both the inner and outer surfaces of the glove once it has been stripped from the former. Both references would lead one of ordinary skill in the art to believe that chlorination is a common treatment to remove or reduce the tackiness of

the rubber, although it may not be a complete solution to the problem according to Teoh et al. Agostinelli discloses chlorinating a glove on a former, albeit it is ultimately the outer surface of the glove that is chlorinated. However, keep in mind that Chen teaches chlorinating both inner and outer surfaces and the prior art of Teoh et al chlorinates the inner surface as in the instant. Based on the teachings of the prior art as a whole, one of ordinary skill would have been led to believe that chlorination reduces tackiness (Teoh et al and Chen) and would have been advantageously applied while the glove is on the former (Agostinelli). Chlorinating while on the former would have also eliminated the two eversion steps taught as time-consuming in the prior art of Teoh et al. One of ordinary skill in this art would have been led to perform a chlorination treatment that has known utility in the art and would have done so in a manner that would have reduced unnecessary steps as taught in the prior art of Teoh et al—ie, chlorination while the glove is till on the former as taught by Agostinelli is submitted to have been an obvious feature in the process of Teoh et al.

Claims 85-87 and 103-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Publication WO 02/32475 (see page 6, first full paragraph; page 8, last paragraph; and page 2, top) in view of Chen (col. 2, lines 6-7; col. 4, lines 35-44), Agostinelli (see Example 1) and Holguin (see paragraphs 0104-0106 and 0115-0116).

Teoh et all, Chen and Agostinelli are applied for reasons of record, the references teaching the basic claimed method lacking essentially the aspect of the hydrogel coating containing an active agent that is capable of imparting a benefit to the user. Holguin discloses incorporating such agents in elastomeric medical films, and it is

submitted that such films would obviously have included films making up a glove. It would have been obvious to one of ordinary skill in the art to modify the hydrogel coating of Teoh et al with an active agent as taught by Holguin to impart to the user protection against contaminating agents.

(7) Response to Argument

(IA) Appellant submits that Teoh et al teaches away from chlorination and considers such to be a "serious disadvantage". However, it is respectfully submitted that such a disclosure would not render chlorination as non-obvious. While it is true that Teoh et al does call chlorination a "serious disadvantage", the reasons why it is considered such are the complicated and time-consuming way the prior art actually performs the chlorination and the **potential** deleterious effects due to the high level of chlorination needed to remove the tackiness. See page 2, top of Teoh et al. If an easier way, one perhaps more time efficient such as chlorinating on the former, were to be used, the chlorination would not be so time-consuming and complicated. Of course, this would only allow the inner—or exposed-- surface to be chlorinated, but if that is what is desired, then such would have been within the skill level of the art as demonstrated by Agostinelli. One of ordinary skill in the art would have known through routine experimentation the exact level of chlorination needed to effectively remove the tack without discoloring or otherwise harming the gloves. Since Chen employs chlorination and the prior art of Teoh et al does also, it must be assumed that chlorination is known in the art as a procedure to remove tackiness. The fact that the

primary reference has found what it considers to be a better solution—or that chlorination has some disadvantages-- does not mean that chlorinating would not have been obvious. Obviousness only requires a reasonable expectation of success, and the fact that the prior art employs chlorination to remove tackiness in dipped rubber products is evidence enough that one would have expected some degree of success employing chlorination. Teoh et al discloses that the hydrogel forming step is used in an overall procedure that does not rely on the prior art chlorination, and indeed the hydrogel on the inner part of the glove may be looked upon as a replacement for chlorination, but there is no definite disclosure that the hydrogel and the chlorination are "mutually exclusive" as argued by appellant. Further, it must be emphasized that even the hydrogel formation is not a complete solution to tackiness removal. As admitted by appellant with the statement of fact 12 at page 7 of the brief, Teoh et al discloses using anionic anti-tack agents in addition to the hydrogel. Increasing the degree of cure to remove surface tackiness is also contemplated--see the middle of page 7 through the middle of page 8 in Teoh et al. Hence, it is rather clear that removing tackiness from the rubber glove can be problematic and one of ordinary skill in the art would realize this and be lead to employ additional treatments in conjunction with the hydrogel layer formation. One such treatment is chlorination.

(IB) While appellant attempts to show why one of ordinary skill in the art would not have combined Chen with Teoh et al, such is not persuasive. The fact that Teoh et al allegedly "teaches away" from chlorination has nothing to do with whether the references would have been combined. Teoh et al discloses applying a **silicone**

lubricant (see the bottom of page 8) to the hydrogel innermost layer and Chen applies a **silicone emulsion** (see column 2, step v) to the innermost layer of a glove. It would have been prime facie obvious to use a silicone emulsion as taught by Chen as the silicone lubricant in Teoh et al. The fact that Chen considers employing an inner hydrogel layer as not being as effective a treatment as powdering the gloves as pertaining to the donning of the gloves has no bearing on the combination of Teoh et al and Chen as applied in the instant rejection. Appellant's arguments that the disclosure of this at column 1, lines 47-54 indicates an "opposing teaching" are simply without merit. Chen is not being relied upon to teach hydrogel layer formation, but rather the form of the silicone lubricant. Also, as will be reiterated later, point IE at page 17 of the brief can also be addressed here. Contrary to appellant's assertion, it is clear that Teoh et al does indeed teach applying a silicone lubricant to the hydrogel layer—see the bottom of page 8 of Teoh et al.

(IC) It would appear from appellant's comments in this section that the "teaching away from" line of argument has simply been taken too far. To suggest that the subsequent disclosure of a reference actually "teaches away" from a previous disclosure of the reference is simply without merit. While Chen may choose to apply later silicone emulsion treatments, this in no way constitutes a teaching away from the earlier, on the former, silicone emulsion treatment.

(ID) The aspect of chlorination has been addressed in the rejection supra. While Agostinelli does indeed chlorinate what is to become the outer surface of the glove, the fact is the reference is applied for teaching chlorination while the glove is on the former,

not the particular side of the glove chlorinated. Unlike Teoh et al and Chen, it would not matter which side is ultimately used as the inner or outer side in Agostinelli, since they would clearly be both the same. Chen has already been noted as teaching chlorination of both the inside and the outside of a glove, and one of ordinary skill in the art would know that either one or both would be advantageously chlorinated.

(IE) The lack of teaching noted by appellant concerning the application of a lubricating layer to the hydrogel layer is in fact taught in Teoh, as noted at the conclusion of paragraph (IB), supra.

Appellant concludes by submitting that the dependent claims rejected with Holguin are patentable for the reasons advanced for the independent claims and that these dependent claims would also be separately patentable. However for reasons already noted such is not persuasive. Appellant has gone to great length to show how the references applied "teach away" from each other, and indeed even to the point that one of the references "teaches away" from its own disclosure. No doubt this is due to the disclosures in the references that certain prior art treatments have certain disadvantages and can be improved upon. One of ordinary skill in the art would expect a patentee to express the prior art in such a fashion. However, it is respectfully submitted that this alone cannot support an argument of "teaching away from" nor should it be construed that references that contain such prior art disclosures cannot be combined on the basis of their prior art disclosure. That is exactly what appellant is attempting to do and it flies in the face of reality. Obviousness only requires a reasonable expectation of success, not an assurance. If the prior art discloses certain

treatments as being effective, then their application would have been obvious for the purpose indicated by the prior art. That is essentially the situation in the instant case under appeal, and that is why the instant claims are submitted to have been obvious over the prior art as applied.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Mathieu D. Vargot/

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